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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,228	02/26/2002	Satoshi Tatsuura	106200.01	4600
7590 05/05/2004			EXAMINER	
Oliff & Berridge PLC P.O. Box 19928 Alexandria, VA 22320			WONG, EDNA	
			ART UNIT	PAPER NUMBER
			1753	
DATE MAILED: 05/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 10/082,228	<b>Applicant(s)</b> TATSUURA ET AL.	
	<b>Examiner</b> Edna Wong	<b>Art Unit</b> 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/571,864.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to the Amendment dated April 22, 2004. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

#### **Specification**

The disclosure has been objected to because of minor informalities.

The objection of the disclosure has been withdrawn in view of Applicants' amendment.

#### **Claim Rejections - 35 USC § 112**

I. Claims **30 and 31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 30 and 31 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

II. Claims **30 and 31** have been rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.

The rejection of claims 30 and 31 under 35 U.S.C. 112, second paragraph, has

been withdrawn in view of Applicants' remarks.

Claim Rejections - 35 USC § 102

Claims **30 and 31** have been rejected under 35 U.S.C. 102(b) as being anticipated by **Rentzepis et al.** (US Patent no. 5,426,686).

The rejection of claims 30 and 31 under 35 U.S.C. 102(b) as being anticipated by Rentzepis et al. has been withdrawn in view of Applicants' amendment.

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

Claims **30-37** are rejected under 35 U.S.C. 102(b) as being anticipated by **Melcher et al.** (US Patent No. 4,217,183).

Melcher teaches an apparatus for electrodeposited film formation comprising:

(i) an electrolyte solution bath **10** holding:

(a) an electrolyte solution **12** containing ions to constitute an electrodeposited film (col. 4, lines 31-32; col. 7, claim 3; and col. 8, claim 7), and

(b) an object to be treated **16** of which at least the surface permits **18** generation of charged particles when irradiated with a laser beam and onto which the electrodeposited film is to be deposited (col. 3, lines 4-18; and col. 4, lines 32-36);

(ii) a pulse laser **22** outputting a laser beam **26** having a pulse width (= from the mechanical light chopper **28**) [col. 4, lines 17-24] and which irradiates at least part of the object to be treated positioned in the electrolyte solution to thereby excite electrons in the laser-irradiated part and form the electrodeposited film at the laser-irradiated part (col. 2, line 65 to col. 4, line 63; and Figs. 1 and 2);

(iii) an opposite electrode **20** (= anode) held separated from the object to be treated **14** in the electrolyte solution **12** (col. 3, lines 20-23; and Figs. 1 and 2); and

(iv) a power source **31** for applying a bias voltage between the object to be treated **16** and the opposite electrode **20** (col. 4, lines 25-30; and Figs. 1 and 2).

The electrolyte solution contains W, Mo, Ni, Cu or Au (col. 7, claim 3; and col. 8, claim 7).

The object to be treated comprises W, Mo, Ni, or Cu (col. 3, lines 7-11).

The electrolyte solution is an aqueous solution (= H<sub>2</sub>O) [col. 4, line 65 to col. 6, Examples].

As to the claim limitations of:

claim 1, lines 8-9, "outputting a laser beam whose pulse width is less than a picosecond", the output of the pulse laser is a recitation with respect to the manner in which the claimed apparatus is intended to be employed and does not differentiate the claimed apparatus from the prior art apparatus because the prior art apparatus teaches all of the structural limitations of the pulse laser (see MPEP 2114); and

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claim 37, lines 1-2, "wherein said aqueous solution contains 2 to 18% by weight plating metal", the aqueous solution is a material worked upon. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim (see MPEP 2115).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

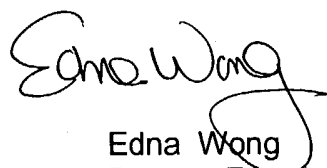
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Edna Wong". The signature is fluid and cursive, with the first name "Edna" and last name "Wong" clearly distinguishable.

Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
May 3, 2004

“Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In *In re Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited “[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface.” An obviousness rejection was made over a reference to Kienze which taught a machine for perforating sheets. The court upheld the rejection stating that “the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienze.” The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and “the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”

Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use. It does not apply to product claims or kit claims (i.e., claims directed to a plurality of articles grouped together as a kit).

## **2116 Material Manipulated in Process**

The materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974).

### **2116.01 Novel, Unobvious Starting Material or End Product**

All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. See MPEP § 2143.03.

*In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In both cases, the Federal Circuit held that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103. Rather, 35 U.S.C. 103 requires a highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art. To support a rejection under 35 U.S.C. 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, applicant’s claimed invention would have been obvious. In applying this test to the claims on appeal in *Ochiai* and *Brouwer*, the court held that there simply was no suggestion or motivation in the prior art to make or use novel, nonobvious products in the claimed processes. Consequently, the court overturned the rejections based upon 35 U.S.C. 103.

Interpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. The decision in *Ochiai* specifically dispelled any



173 USPQ 685, 688 (CCPA 1972).

## **2114 [R-1] Apparatus and Article Claims — Functional Language**

For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see MPEP § 2181 - § 2186.

### **APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART**

>While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); <*In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

### **MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART**

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

### **A PRIOR ART DEVICE CAN PERFORM ALL THE FUNCTIONS OF THE APPARATUS CLAIM AND STILL NOT ANTICIPATE THE CLAIM**

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. It should be noted, however, that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

## **2115 Material or Article Worked Upon by Apparatus**

### **MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS**